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ATTENTION: KEN WIEDER
SPECIAL PROGRAM EXAMINER
TC 2700

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicants: M. OTA et al.

Serial No.: 08/816,891

FEB 05 1999

Filed: March 13, 1997

Special Program Unit
Group 2720For: MATRIX PANEL DISPLAY APPARATUS AND DRIVING
METHOD THEREFOR WHEREIN AUXILIARY SIGNALS
ARE APPLIED TO NON-SELECTED PICTURE
ELEMENTS

Group: 2775

Examiner: C. Nguyen

PETITION TO THE COMMISSIONER UNDER 37 CFR 1.181(a)(1)
FOR WITHDRAWAL OF OFFICE ACTION ON MERITS, ISSUANCE OF
NEW OFFICE ACTION REQUIRING ELECTION OF SPECIES, AND
RESTARTING OF PERIOD FOR RESPONSE

Assistant Commissioner for Patents
Washington, D.C. 20231

August 17, 1998

Sir:

The Office Action of August 6, 1998, in connection with the above-identified Rule 62 divisional application is acknowledged. The Office Action of August 6, 1998, is the first Office Action issued in the present Rule 62 divisional application, and is an Office Action on the merits.

In the Office Action of August 6, 1998, the Examiner has assumed that the applicants have elected the species of Fig. 22 for prosecution on the merits in the present Rule 62 divisional application, has withdrawn claims 23-33 from consideration as allegedly not being readable on the allegedly elected species of Fig. 22, and has considered claims 17-22

and 34 on the merits as being readable on the allegedly elected species of Fig. 22.

However, for the reasons discussed below, it is submitted that the applicants have not yet elected a species for prosecution on the merits in the present Rule 62 divisional application, such that it was improper for the Examiner to issue the Office Action on the merits of August 6, 1998, based on the Examiner's assumption that the applicants have elected the species of Fig. 22 for prosecution on the merits in the present Rule 62 divisional application.

It is respectfully requested that a decision on this petition be issued before the due date of November 6, 1998, for filing a response set in the Office Action of August 6, 1998.

STATEMENT OF THE FACTS

On March 13, 1997, the applicants filed the present Rule 62 divisional application as a Rule 62 divisional application of application Serial No. 08/139,904, together with a preliminary amendment dated March 13, 1997.

The present Rule 62 divisional application is being examined by Primary Examiner Chanh Nguyen, who also examined parent application Serial No. 08/139,904.

In the Office Action of February 5, 1996, issued in parent application Serial No. 08/139,904, the Examiner required the applicants to elect one of the following six patentably distinct species of the claimed invention:

- A. Species of Fig. 4
- B. Species of Fig. 5
- C. Species of Fig. 14
- D. Species of Fig. 17
- E. Species of Fig. 22
- F. Species of Fig. 24

In the response of March 1, 1996, filed in parent application Serial No. 08/139,904, the applicants traversed the requirement for an election of species, but provisionally elected with traverse species A (Fig. 4) for prosecution on the merits, with claims 1-16 being readable thereon and with no claim being generic.

In the Office Action of May 15, 1996, issued in parent application Serial No. 08/139,904, the Examiner maintained the requirement for an election of species set forth in the Office Action of February 5, 1996, and withdrew claims 17-34 from consideration, stating as follows (emphasis added):

Applicant's election with traverse of the invention elected in Paper No. 10 is acknowledged. The traversal is on the ground(s) that applicant considered that no other patentably distinct species is considered to be present by Examiner. This is not found persuasive because claims 17-34 are directed to twelfth embodiment (figure 22) of this instant application. The requirement is still deemed proper.

The Examiner then considered claims 1-16 on the merits and rejected them over the prior art.

In the amendment of August 15, 1996, filed in parent application Serial No. 08/139,904, the applicants cancelled claim 6 and traversed the rejection of claims 1-5 and 7-16 over the prior art set forth in the Office Action of May 15, 1996.

In the final Office Action of November 13, 1996, issued in parent application Serial No. 08/139,904, the Examiner maintained the rejection of claims 1-5 and 7-16 over the prior art set forth in the Office Action of May 15, 1996.

In the preliminary amendment of March 13, 1997, filed in the present Rule 62 divisional application, the applicants expressly withdrew their election of species A (Fig. 4) in parent application Serial No. 08/139,904, and cancelled claims 1-5 and 7-16 which had been under consideration in parent application Serial No. 08/139,904 as being readable on elected species A (Fig. 4), leaving claims 17-34 pending in the present Rule 62 divisional application. The applicants did not elect a species for prosecution on the merits in the present Rule 62 divisional application.

In the Office Action of August 6, 1998, issued in the present Rule 62 divisional application, the Examiner has assumed that the applicants have elected species E (Fig. 22) for prosecution on the merits in the present Rule 62 divisional application, has withdrawn claims 23-33 from consideration as allegedly not being readable on allegedly elected species E (Fig. 22), has considered claims 17-22 and 34 on the merits as being readable on allegedly elected species E (Fig. 22), and has rejected claims 17-22 and 34 over the prior art, stating as follows in pertinent part (emphasis added):

Applicant withdraw the election of species A as elected in parent application 08/139,094 by canceling claim 1-16. It appears that Applicant elects new species

of figure 22. Claims 23-33 are withdrawn from consideration since claims 23-33 are not readable on species of figure 22. For example, the limitation "applying bias signals to scanning lines" as recited in claim 24 as well as the limitation "bias signal generation circuit includes a scanning generating circuit" as recited in claim 23 are not readable on species of figure 22.

However, it is submitted that the applicants have not elected species E (Fig. 22) for prosecution on the merits in the present Rule 62 divisional application as apparently alleged by the Examiner. It is submitted that there is absolutely no basis whatsoever in the applicants' comments in the preliminary amendment of March 13, 1997, filed in the present Rule 62 divisional application for the Examiner's statement that "[i]t appears that Applicant elects new species of figure 22".

What the applicants did in the preliminary amendment of March 13, 1997, filed in the present Rule 62 divisional application was to withdraw their election of species A (Fig. 4) in parent application Serial No. 08/139,904 without electing a species for prosecution on the merits in the present Rule 62 divisional application.

Furthermore, it is submitted that the Examiner's statement that "[c]laims 23-33 are withdrawn from consideration since claims 23-33 are not readable on species of figure 22" is directly contrary to the Examiner's statement in the Office Action of May 15, 1996, issued in parent application Serial No. 08/139,904 that "claims 17-34 are directed to twelfth embodiment (figure 22)".

Since the applicants have not yet elected a species for prosecution on the merits in the present Rule 62 divisional application as discussed above, it is submitted that it was improper for the Examiner to issue the Office Action on the merits of August 6, 1998, based on the Examiner's assumption that the applicants have elected species E (Fig. 22) for prosecution on the merits in the present Rule 62 divisional application.

RELIEF REQUESTED

Since it was improper for the Examiner to issue the Office Action on the merits of August 6, 1998, for the reasons discussed above, pursuant to 37 CFR 1.181(a)(1) and MPEP 710.06, it is respectfully petitioned that the Office Action of August 6, 1998, on the merits be withdrawn, that a new Office Action requiring an election of species be issued, and that the period for response be restarted.

Respectfully submitted,

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Serial No. 08/816,891 Filed March 13, 1997
Applicant(s) M. OTA et al.
Papers filed herewith on August 17, 1998

- ☐ Fees \$ _____ ☐ Assignment
☐ New Application ☐ Letter to Draftsman
☐ Amendment ☐ Priority Documents
☐ Notice of Appeal ☐ Petition for Ext. of Time
☐ Appeal Brief ☐ _____ Sheets of Formal Drawings
☒ Other Papers as the Commissioner Under 37 CFR

1.181(a)(1) for Withdrawal of Office Action on Merits,
Issuance of New Office Action Requiring Election of
Species, and Restarting of Period for Response

Receipt is hereby acknowledged of the papers filed as indicated in connection with above identified case.
COMMISSIONER OF PATENTS AND TRADEMARKS